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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,006	08/31/2001	J. Pat Evans	10368/24701	1607

24349 7590 08/09/2005

WILLIAM R. GUSTAVSON  
SUITE 1185  
9330 LBJ FRWY.  
DALLAS, TX 75243

EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/945,006	EVANS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony Stashick	3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17,42,43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17,42,43 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-11, 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroer, Jr. et al. 5,282,326. Schroer, Jr. et al. '326 discloses all the limitations of the claims including the following: an insole 2 having a raised arch support portion (see Figure 5a, area 22) with the peripheral contour of the arch section generally conforming to the longitudinal arch and transverse arch of the plantar surface of a user's foot (see Figures 1 and 3); the peripheral contour is defined by a curve having a first endpoint located on a medial edge of the insole (see Figure 1) generally corresponding to a forward most medial point of the longitudinal arch; a second endpoint located rearward of the first endpoint on the medial edge of the insole (also Figure 1); the curve extends forwardly and laterally (Figure 1) from the first endpoint through a point generally corresponding to a midway point between second and third metatarsal heads of the foot and rearwardly along the medial edge of the fifth metatarsal head of the foot then rearwardly and medially to the second endpoint (see Figure 1); the curve extends across a point generally corresponding to a cuboid of the foot; the raised arch support portion forms part of the foot bed (see Figure 3); the raised arch support portion has a maximum height dimension substantially midway between a first metatarsal head and an Astragalus of the human foot (see Figure 3); the raised arch support portion has a maximum height dimension midway between a

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Tibialis Anticus of the human foot (see Figure 3); the insole has dimensions that generally correspond to a human foot of predetermined size; the insole is capable of supporting substantially all of the plantar surface of the human foot (see Figure 3); a surface layer 12 provided on the upper surface of the foot bed; the foot bed has a hind foot region and a forefoot region and is made of flexible material (see col. 5, line 49-col. 6, line 66).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroer, Jr. et al. 5,282,326. Schroer, Jr. et al. '326 discloses all the limitations of the claims as noted above. Although Schroer, Jr. et al. '326 does not specifically state the height of the arch support portion, it appears that it would have been a mere matter of design testing an evaluation to find what the average height is for the arch portion of a persons foot and use that height to be the support height of the arch support portion since this portion would be used to support the arch of the average user. With respect to claim 16, it is well known in the art of insole making to make the top layer of an insole out of a textile material to aid in giving comfort to wearing the shoe and to aid in wicking away perspiration.

5. Claims 42-43 and 45 are rejected under 35 U.S.C. 103(a) as being obvious over Schroer, Jr. et al. 5,282,326 as applied to claim 9 above in view of Official Notice. Schroer, Jr. et al. '326

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discloses all the limitations of the claims except for the claimed Shore Hardness, density and Ball Rebound. Official Notice is taken that it is well within the skill of one of ordinary skill in the art to find a material that would meet the desired Shore Hardness density and Ball Rebound to aid in cushion, comfort and stability of the user's foot within the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to find a polyurethane material that would meet these desired characteristics. Furthermore, since the Ball Rebound value is defined by ASTM, it appears that this would not be inventive, as it is a requirement that has already been set to be met.

#### Response to Arguments

6. Applicant's arguments with respect to the 112 issues will be clarified here. The point made in the last Office action was that, since applicant has stated that "there is no more definitive way to properly describe the invention" except in relation to a user's foot, this argument was persuasive to remove the 112 second paragraph issue in the last Office action. The Office, as a whole, does not allow for invention to be defined by claiming body parts unless this is the only way that the invention can be clearly defined, as is assumed the case here with respect to applicant's arguments. Therefore, the 112 second paragraph rejections have been withdrawn for this reason. If applicant believes that there is another way to define applicant's invention without claiming the user's body parts, then applicant is required to do so and cancel the claims that claim a user's body parts. Applicant argues that the figures of Schroer et al. do not provide disclosure for the claimed subject matter and that "It is well established that patent drawings are not blue prints." This argument is not completely understood. It has been well established that

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drawings are part of the disclosure and can teach one that which can be gleaned from what is shown in those drawings. The figures of Schroer et al. clearly show the limitations in the positions as claimed by applicant. Applicant argues that the positioning of the arch support in Schroer et al being in the same place as that shown by applicant is not relevant. This argument is not clear. Supports located in the same place as that claimed and shown by applicant and at the same heights, would operate in the same fashion as that claimed, otherwise applicant's invention as shown would not operate as claimed. Applicant argues that the ASTM standard does not provide anticipation. This argument is not clear. The ASTM standards are guidelines set that applicant finds necessary to meet. Therefore, this set of parameters is not inventive by applicant since applicant needs to meet these guidelines set forth by a governing body.

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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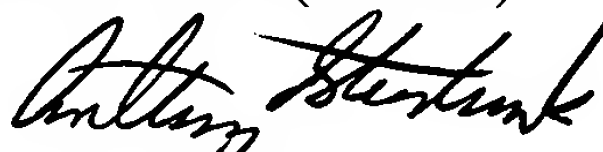
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS